

## IN THE UNITED STATES PATENT OFFICE

Applicant: Stephen R. Welch )

Serial No.: 09/852,996 )

Filed: 05/10/2001 )

For: Method And Apparatus For  
Forming A Binder Cover And  
A Ring Cover )PATENT APPLICATION

Examiner M. T. Henderson

Group Art Unit 3722

Dkt #4004022.0026

Commissioner of Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450**REQUEST FOR WITHDRAWAL OF  
HOLDING OF ABANDONMENT UNDER MPEP § 711.03c**

Dear Sir:

This request is for the withdrawal of the holding of abandonment based on the following fact situation.

On December 20, 2002 the Patent Office issued a non-final action rejecting Claim 16 over Welch U.S. Patent No. 6,394,729 under 35 USC 102 and Claims 7 and 8 under 35 USC 103(a) as being unpatentable over Welch U.S. Patent No. 6,394,728 in view of Kistner U.S. Patent No. 3,995,849. Of the remaining claims in the application, Claims 1-6 were allowed and Claims 9-15 and 17-20 were objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. (While 31 claims were pending in the application, Claims 21-31 were withdrawn from consideration as not being drawn to the elected invention.)

Upon taking up the application to respond to the outstanding Official Action during the month of February the failure of the Welch patent to qualify as prior art was ascertained and since in our view the Welch patent was not eligible to be considered as

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prior art, it was believed that the application would be allowable unless during further searching equivalent or better art turned up. For record purposes the Welch patent No. 6,394,729 is the same inventor as applicant in the instant application. The filing date of the '729 patent of December 8, 2000 and issue date of May 28, 2002, almost a year after the filing date of the instant application, precludes it from being a reference against Mr. Welch's instant application that was filed on May 10, 2001.

Mr. Henderson, the Examiner in this application, was contacted by telephone on February 20, 2003, well within the 3 month response period, with the aim of having him reconsider his rejection and issue either a Notice of Allowance or a new action based on other art he may turn up if he chose to make a further search.

His initial reaction to my telephone inquiry was that he would review the matter and get back to me. According to the notes in my file, on February 20 he called me and said that I was correct and that Welch was not an applicable reference and that I should ignore the Official Action and that he would issue a new one.

I specifically inquired of Mr. Henderson if I should file a paper recording our conversation and he was very specific to the effect that I should ignore the action and that I would be receiving a new one and thus a response should not be filed. I returned the application to our files awaiting a new action.

On June 20, 2003, which coincidentally was the expiration of the six (6) month statutory period, the original action was a typical three (3) month reply period, Mr. Henderson called me ostensibly to discuss this application. During our conversation, I referred to our earlier February 20<sup>th</sup> telephone call and Mr. Henderson recalled our discussion with regard to the inapplicability of the Welch '729 patent but did not recall the portion of our discussion relating to my understanding that I should ignore the action and await a new action in the case.

After discussing the situation with Mr. Henderson, I subsequently discussed the situation with Mr. Stephen Marcus, his supervisor, and I was advised that I would have to proceed by way of a petition. Mr. Marcus stated that Mr. Henderson had no authority to allow me to ignore the action and that I was obligated to respond to the action setting

forth my arguments. I regret that I did not respond earlier to the Official Action but I believed that I was acting responsibly in not filing a response since the elimination of the Welch '729 patent as a reference would expedite the prosecution of the application and was likely to result in a Notice of Allowance and a new Official Action would move along the case more quickly.

I have prepared a response which is attached hereto setting forth that Welch '729 is not applicable prior art and that upon elimination of this reference it is respectfully submitted that the application is in condition for allowance and such action is solicited.

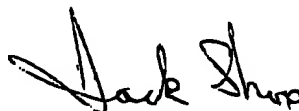
It is requested that in view of the above the application should be revived and a new action rendered without the utilization of Welch '729 as a reference.

Immediately subsequent to the phone call on June 20<sup>th</sup> I made of record my phone discussions with Messrs. Marcus and Henderson and I prepared and am submitting this Petition as soon as is was feasibly possible.

If I understood Mr. Marcus correctly, this Petition does not require a fee. However, if we are in error and a fee is required, please charge any fees to deposit account number 134825.

If the Office has additional questions, please contact the undersigned at the number listed below.

Respectfully submitted,



Jack Shore


Registration No. 17,551

June 25, 2003

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Carolyn R. Gutwaks

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Attorney Docket No. 4004041.0025

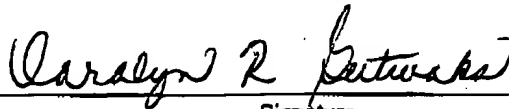
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Attached is a Request for Withdrawal of Holding of Abandonment Under  
MPEP Section 711.03c and a Response.

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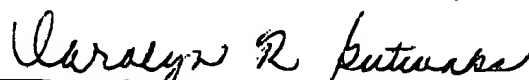
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Carolyn R. Gutwaks